

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 24-25, 28, 32, 34, 36-60, 70-85 are presently active in this case. The present Amendment adds new Claims 81-85.

The outstanding Office Action rejected Claim 80 under 35 U.S.C. § 102(b) as anticipated by Holland (U.S. Patent No. 4,458,701).

Claims 24, 25, 28, 32, 34, 36-60 and 70-79 were allowed. Applicant acknowledges with appreciation the indication of allowable subject matter.

In order to vary the scope of protection recited in the claims, new dependent Claims 81-85 are added. New Claims 81-85 find non-limiting support in the disclosure as originally filed, for example in Figs. 1 and 3 and at page 8, lines 4-16. Therefore, the changes to the claims are not believed to raise a question of new matter.¹

In response to the rejection of Claim 80 under 35 U.S.C. § 102(b), Applicant respectfully requests reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly recapitulating, Applicant's invention, as recited in Claim 80, relates to a set for applying a product. The claimed set includes a container for containing a reserve of product, and an applicator capable of being arranged removably in the container. The applicator includes an element for grasping equipped with a comb comprising an *arrangement of teeth* capable of applying the product. The arrangement of teeth is obtained by assembling at least two distinct parts that are different in shape from each other such that the parts are not mirror images of each other. After assembling, the two parts include a first part with teeth inclined

¹ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

in a first direction and a second part with teeth inclined in a second direction different from the first direction. The two parts are joined together pivotably by *a film hinge*.

Turning now to the applied prior art, the Holland patent discloses a double brush mascara applicator based on a one-piece construction. The brush includes a pair of members, including an upper brush backing member 16 that holds brush bristles 18 and a lower brush backing member 17 that holds brush bristles 19. However, the Holland patent fails to disclose the claimed set. In particular, the Holland patent fails to disclose an arrangement of *teeth*. Instead, the Holland patent discloses *a brush* with upper brush bristles and lower brush bristles. Further, the Holland patent does not disclose an arrangement that is obtained after assembling the upper and the lower brush. Instead, as can be seen in Holland's Figs. 1 and 3, the Holland brush is obtained even if the upper brush and the lower brush are not assembled and are at a distance from each other. Finally, the two parts 16, 17 having bristles are not joined together pivotably by *a film hinge*, but by arms 20 and 21 which are thicker than the arms 22, 23 from which extend the bristles and by the thickened portion 24. These thick portions can not reasonably be considered as meeting the claimed film hinge.

Therefore, the Holland patent fails to disclose every feature recited in Applicant's claims, so that Claims 80-85 are not anticipated by the prior art. Accordingly, Applicant respectfully traverses, and requests reconsideration of the 35 U.S.C. § 102 rejection based on the Holland patent.²

Further, there is no apparent reason to modify the Holland brush so as to arrive at Applicant's claimed set with an arrangement of teeth. The position that the Holland brush *could* be modified to arrive at the claimed inventions would be insufficient to establish a prima facie case of obviousness. Thus, Applicant respectfully submits that the subject matter

² See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

of Claims 80-85 is not rendered obvious by the Holland patent to a person of ordinary skill in the art.

New dependent Claims 81-85 also recite features that are not disclosed by the Holland patent. For example, Claim 81 requires that the two parts include a first *linear* part with teeth inclined in a first direction and a second *linear* part with teeth inclined in a second direction different from the first direction. By contrast, the Holland patent explicitly teaches that the member 16 is “arcuate” and “curved so as to fit easily upon the surfaces of the eyelashes,” and that the member 17 is also “arcuate” and “also curved so as to fit easily upon surfaces of the eyelashes.”³

Finally, with respect to the indication that the IDS filed July 7, 2008 did not comply with Rule 98, Applicant notes that the purpose of the IDS was simply to disclose English translations of Japanese Office Actions so as to be placed in the application file. The IDS did not include a Form 1449 because the reference cited in these Japanese Office Actions are already of record in the present application and have already been acknowledged as having been considered. Therefore, no further action is believed to be required, nor is any further action being requested.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 24-25, 28, 32, 34, 36-60, 70-85 is earnestly solicited.

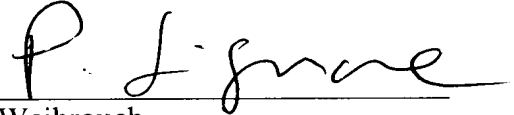
³ The Holland patent at column 3, lines 1-7.

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Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read "P. J. Signore", is written over a horizontal line.

Steven P. Weihrouch
Attorney of Record
Registration No. 32,829

Philippe J.C. Signore, Ph.D.
Registration No. 43,922

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)